IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PIONEER HI-BRED INTERNATIONAL, INC,

Plaintiff,

v.

SYNGENTA SEEDS, LLC,

Defendant.

Civil Action No. 22-1280-RGA

MEMORANDUM ORDER

Before me is Plaintiff's motion for clarification of a claim term I construed after a Markman hearing. (D.I. 111). I have considered the parties' briefing. (D.I. 111, 116, 121). For the reasons set forth below, I will modify my claim construction. I think that doing so will moot Plaintiff's motion.

The disputed term is step (b) of claim 1 of U.S. Patent No. 8,859,846 ("the '846 patent"). Step (b) states, "isolating said haploid maize embryo between 4-21 days after step (a), wherein said at least one haploid maize embryo is distinguished from the diploid maize embryos via expression of a marker." ('846 patent at 18:33–36). I construed step (b) as, "isolating the at least one haploid maize embryo between 4-21 days after step (a), wherein the at least one haploid maize embryo is distinguished from the diploid maize embryos at or before isolation via expression of a marker." (D.I. 108 at 7–11; D.I. 110 at 1). Plaintiff seeks to clarify that construction. (D.I. 111).

Plaintiff argues that "isolating" refers to more than just extraction. (*Id.* at 2). Plaintiff contends that "'isolating' includes 'selecting the at least one haploid maize embryo from among

the haploid and diploid maize embryos produced in step (a).'" (D.I. 111-2 at 1). Plaintiff thus argues that "the at least one haploid maize embryo" must be selected between four and twenty-one days after step (a) of claim 1. (D.I. 111 at 2). Plaintiff contends its position is consistent with my decision to not adopt the parties' request to replace "isolating" with "extracting" in step (b). (*Id.*). Plaintiff further argues that the intrinsic evidence and my comments at the Markman hearing support its position. (*Id.* at 3–4).

Defendant contends that no clarification is needed. (D.I. 116 at 1).[1] Defendant argues the parties have not disputed the meaning of "isolating" before. (*Id.*). Defendant contends that the parties "have always agreed that 'isolating' means 'extracting' or 'isolating from the kernel' i.e., the physical act of removing an embryo from a maize kernel." (*Id.*). Defendant argues that Plaintiff merely wants to "revive its failed argument" that haploid embryos may be distinguished after they are extracted. (*Id.* at 2–3). Defendant argues that the '846 patent does not support construing "isolating" to include "selecting." (*Id.* at 4).

Plaintiff replies that Defendant's approach would read additional limitations into the claim. (D.I. 121 at 1). Referring to the presumption that different terms have different meanings, Plaintiff argues that "isolating" and "extracting" are different. (*Id.* at 2).

I think Defendant is right that the parties have not disputed the meaning previously. The parties originally proposed replacing "isolating" with "extracting . . . from a kernel of the maize ear" in step (b) of claim 1. (D.I. 72 at 10–11). At the Markman hearing, Plaintiff remained true to that proposal, stating that "isolating" and "extracting" mean the same thing. (*See, e.g.*, D.I. 105 at 30:18–22 ("Well, I think the parties are in agreement. We're talking about extracting

[1] Defendant alternatively proposes the following clarification: "'isolating' refers to extracting, i.e., the physical act of removing an embryo from a kernel of the maize ear." (D.I. 116-1 at 1).

these embryos from the kernels."); *id.* at 66:8–11 ("I think they also explain in their brief that there is agreement that the act of isolating is the act of extracting it from the kernel.")).[2] Given that the parties used the two words interchangeably and step (b) of claim 1 already included the word "isolating" (*see* '846 patent at 18:33), I thought it unnecessary to replace "isolating" with "extracting." Plaintiff now infers that I thought "isolating" meant something different than "extracting." Since that is not the case, and to avoid confusion down the road, I amend my previous construction. Where it says "isolating," it should be changed to say, "extracting . . . from a kernel of the maize ear."

The parties should resubmit the claim construction order as modified by the above.

I thus **DISMISS** Plaintiff's motion (D.I. 111) as moot.

IT IS SO ORDERED.

Entered this 14th day of December, 2023

United States District Judge

[2] Defendant also used the words "isolating" and "extracting" interchangeably. (*See* D.I. 116 at 1).